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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,595	08/01/2000	Scott W. Rau	47004.000049	5920

21967 7590 04/20/2005

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EXAMINER

FISCHER, ANDREW J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/630,595

**Applicant(s)**

RAU ET AL.

**Examiner**

Andrew J. Fischer

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 C.F.R. §1.114***

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on January 12, 2005. This application was under a final rejection (the "Third Final Office Action", mailed September 13, 2004) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the Third Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

### ***Acknowledgements***

2. In accordance with the RCE noted above, Applicants' after final amendment filed November 29, 2004 has been entered. Accordingly, claims 26-33 and 35-40 remain pending.
3. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
4. The amendments to the specification & drawings has been entered.
5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

***Claim Rejections - 35 USC §101***

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 26-33 and 35-40 are rejected under 35 U.S.C. §101 because the disclosed invention is inoperative and therefore lacks utility.

7. Claim 26 recites "receiving at least some financial account information linked to the transponder identification information . . . ." However the claim also ends with "wherein the transponder identification information does not comprise financial account information." These two statements are mutually exclusive and thus an impossible limitation. In other words, if the "transponder identification information does not comprise financial account information," it is impossible for the "some financial account information [to be] linked to the transponder identification information. If it was linked, it would in fact *contain* financial account information.

***Claim Rejections - 35 USC §112 1<sup>st</sup> Paragraph***

8. The following is a quotation of the 1<sup>st</sup> paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 26-33 and 35-40 are rejected under 35 U.S.C. §112, 1<sup>st</sup> paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10. Claim 26 recites "receiving at least some financial account information linked to the transponder identification information . . . ." However the claim also ends with "wherein the transponder identification information does not comprise financial account information." These two statements are mutually exclusive and thus the claim contains an impossible limitation. "A claimed invention having an inoperable or impossible claim limitation may lack utility under 35 U.S.C. §101 and certainly lacks an enabling disclosure under 35 U.S.C. §112." *EMI Group North America, Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423, 1427 (Fed. Cir. 2001) (citations omitted).

***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

11. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 26-33 and 35-40 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claim 26, it is unclear what the term "of at least one of" (in line 3) means. It is unclear if e.g. the issuing bank must own the transponder or simply be in connection with the transponder.

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- b. In claim 26, it is unclear what information is in the "account table. On one hand it could be the "some financial information" yet on the other hand, it could be the "transponder identification information." Appropriate correction is required.
- c. Because claim 26 contains inoperable subject matter, the scope of the claims is indefinite. Should Applicants overcome the §101 and §112 1<sup>st</sup> paragraph rejections above, this particular 35 U.S.C. §112, 2<sup>nd</sup> paragraph rejection will be withdrawn.
- d. The claim 27 is indefinite because the status of the claim is unclear.
- e. In claim 35, it is unclear if Applicants intended list of items is conjunctive or disjunctive. In other words, must only one item be present for anticipation/infringement (*e.g.* "a debit card account"), or alternatively, must all six (6) elements be present for anticipation/infringement? If all six (6) elements are required, it is unclear how all are present in a single transaction.

***Claim Rejections - 35 USC §102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another, filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant

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for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 26-33 and 35-40, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Hennige (U.S. 5,276,311). Hennige discloses an ordinary credit transaction including receiving by a transponder server of a credit network at least some transponder identification information (credit account number) emitted from a transponder (contacts 100 in the credit card) substantially upon presentation of both the transponder and a transaction for payment at a POS device, the payment comprises a payment amount (inherent in all payments); receiving (at the credit authorization agency) at least some financial account information (the account number transmitted from the merchant) linked to the transponder identification information in an account table (the table includes account holder's name, billing address, available balance and credit, etc.); determining authorization based on the payment amount (inherent since a credit card company would not authorize a \$40,000 purchase if the customer had only a \$10,000 available line of credit); communicating authorization to the POS device (approving or rejecting the credit purchase); paying the authorized payment amount to a merchant account associated with a merchant (the credit card company pays the merchant); issuing the transponder (credit card) to the holder of the account (the consumer); receiving the transponder identification information from multiple POS devices (inherent since the consumer can use his or her credit card at multiple POS devices); the account type is a credit card; the transponder is embedded in a transaction card (contacts 100 are embedded in the overall card); and registering the financial account information (activating the credit card) via a network registration interface (a telephone).

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15. The Examiner notes that this rejection relies on the definition of transponder as request by Applicants. See Applicants response filed November 12, 2004, note 1 where Applicants cite to Exhibit A (also filed November 12, 2004) and state what is the “common understanding” of transponder: “Whatis.com defines a passive transponder as a device that ‘allows a computer or robot to identify an object. Magnet labels, such as those *on credit cards* and store items, are common examples. [Emphasis added.]” It is the Examiner’s position then that even *if* Applicants’ definition for transponder is used, the magnetic strip on a ordinary credit card is a transponder. See the ‘Response to Arguments’ section *infra* for a discussion of how the Examiner interprets transponder.

16. Claims 26-33 and 35-40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §102(b) as being anticipated by Jun et. al. (U.S. 5,828,044)(“Jun”). Jun discloses the claimed invention including an RF transponder.

17. Claims 26, 35, 37, and 38 as understood by the Examiner, are alternatively rejected under 35 U.S.C. §102(e) as being clearly anticipated by Brook, Jr. et. al. (U.S. 6,424,884 B1) (“Brook”).

18. Claims 26-33 and 35-40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §102(b) as being clearly anticipated by Randelman et. al. (U.S. 5,072,380)(“Randelman”).

### ***Claim Rejections - 35 USC §103***

19. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and



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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 26-33 and 35-40, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Jun.<sup>1</sup> It is the Examiner's principle position that the claims are anticipated because it is inherent that the transponder is of a credit network.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jun to include the transponder is of a credit network. Such a modification would have isolated the transponder by making it only available for purchases allowing for a faster transaction.

21. Claims 26-33 and 35-40, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Brook.<sup>2</sup> It is the Examiner's principle position that the claims are anticipated because it is inherent that the transponder is of a credit network.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jun to include the transponder is of a credit network. Such a modification would have isolated the transponder by making it only available for purchases allowing for a faster transaction.

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

<sup>2</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

22. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions. First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements<sup>3</sup> with the required clarity, deliberateness, and precision.<sup>4</sup> Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked, Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer. Finally, after receiving express notice of the preceding factual findings

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<sup>3</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>4</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs*

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and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicants have decided not to be their own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.<sup>5</sup>

23. Under the broadest reasonable interpretation standard noted above and unless modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Actions. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary<sup>6</sup>) during ex parte examination.

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*Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>5</sup> See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . [Emphasis added.]"

<sup>6</sup> See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

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24. The Examiner maintains his position on functional recitations. See *e.g.* the Office Action mailed March 4, 2003, Paragraph No. 14 and Applicants' responses thereto.

25. The Examiner maintains his position

### ***Response to Arguments***

26. Applicant's arguments filed November 11, 2004 have been fully considered but they are not persuasive.

### ***Transponder***

27. The Examiner notes again that Applicants have not used either lexicography or 35 U.S.C. 112 6<sup>th</sup> paragraph to properly incorporate the specification into the claims.

Because Applicants have not used either lexicography or 35 U.S.C. 112 6<sup>th</sup> paragraph to properly incorporate the specification into the claims and because of *In re Morris*, the Examiner is free to use any reasonable definition of transponder. The Examiner is not bound by Applicants' definition.

28. In other words, "Absent an express definition in their specification [*i.e.* lexicography], the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation." *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029. In this particular case, the Examiner points to The IEEE Standards Standard Dictionary of Electrical and Electronic Terms which states a transponder is "A device that responds to a physical or electrical stimulus and emits an electrical signal in response to the stimulus." The IEEE Standards Standard Dictionary of Electrical and

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Electronic Terms, 6<sup>th</sup> Ed., IEEE, Inc., New York, NY, 12/1997. Unless expressly noted otherwise by the Examiner, the Examiner has adopted this definition for transponder when interpreting the claims.

29. Next, Applicants' argue that "the definition of the term 'transponder' as a credit card is incorrect because an ordinary credit card does not 'emit' any information."<sup>7</sup> This is not persuasive. Applicants *own statements* in note 1 on page 11 expressly points out that a passive transponder may include "[m]agnetic labels, such as those on credit cards . . ." Thus, even if a reviewing body somehow finds Applicants' own definition of transponder is controlling, Applicants' argument<sup>8</sup> and exhibit expressly confirm that an ordinary magnetic strip on a credit card is a 'transponder.' Applicants arguments have therefore been considered but are not persuasive.

***"In light of the Specification"***

30. Applicants also argue that "[t]he Examiner's construction of the term 'transponder' is inconsistent with the specification."<sup>9</sup> The Examiner has considered Applicants position but finds that this point is immaterial to claim construction during ex parte examination. It appears Applicants have confused claim construction during ex parte examination with claim construction during inter partes litigation. During ex parte examination, the Examiner is required to use the broadest reasonable interpretation.

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<sup>7</sup> Applicants' Remarks filed November 11, 2004, Page 11, 2<sup>nd</sup> ¶ in §D.

<sup>8</sup> See *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 979, 977, 52 USPQ2d 1109, 1113 (Fed. Cir. 1999)( "Arguments made during the prosecution of a patent application are given the same weight as claim amendments.")(citations omitted).

<sup>9</sup> Applicants' Remarks filed November 11, 2004, Page 12, 2<sup>nd</sup> ¶.

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31. However during inter partes litigation, courts must look to the specification for a meaning that is consistent with the specification.<sup>10</sup> To be clear, this different method of interpreting the claims is not optional:

[T]he Board is *required* to use a different standard for construing claims than that used by district courts. We have held that it is *error for the Board to apply the mode of claim interpretation that is used by courts in litigation*, when interpreting the claims of issued patents in connection with determinations of infringement and validity. Instead, as we explained above, the PTO is obligated to give claims their broadest reasonable interpretation during examination. [Emphasis added.]” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).

32. In fact, the Federal Circuit has continually warned the Board about improperly reading the specification into the claims:

“Nevertheless, this court counsels the PTO to avoid the temptation to limit broad claim terms solely on the basis of specification passages. Absent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition . . . .” *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004)(citations omitted).

33. Finally and if there is any doubt, the Examiner notes that the MPEP also supports the Examiner’s position that *only* lexicography or 35 U.S.C. 112 6<sup>th</sup> paragraph are available during ex parte examination to incorporate the specification into the claims.

MPEP §2111.01<sup>11</sup> begins:

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is *not the*

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<sup>10</sup> For inter partes litigation, see *e.g. Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996)( “it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning.”)(citations omitted).

<sup>11</sup> MPEP §2111.01, 8<sup>th</sup> Edition, Rev 2, May 2004.

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*mode* of claim interpretation to be applied during examination. . . . It is *only when* the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language [*i.e.* Factor 1: Lexicography]. . . . There is one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language). In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. [Underline in original. Italics added. Citations omitted.]

34. Thus the MPEP clearly states that during ex parte examination, the specification can be used to interpret the claims “only when” attempting to use either lexicography and/or 35 U.S.C. §112 6<sup>th</sup> paragraph. The reasoning behind this principle was clearly stated in the ex parte examination case of *In re Prater*. “There are quite sound reasons why, in an infringement suit on an issued patent, courts may sometimes interpret patent claims in the light of the specification so as to protect only that phase of the claimed invention that constitutes patentable subject matter and thus do justice and equity between the parties.” *In re Prater*, 415 F.2d 1393, 162 USPQ 541, 550 (CCPA 1969) (citations omitted).

35. In this case, it is now well established that Applicants have not used either lexicography or 35 U.S.C. §112 6<sup>th</sup> paragraph to interpret the claims. Beginning with the first office action on the merits, the Examiner has continually espoused the position that during ex parte examination, only lexicography and 35 U.S.C. §112 6<sup>th</sup> paragraph may properly incorporate the specification into the claims. It is expressly for this reason that the Examiner had gone to great lengths to ensure that Applicants had decided not to be their own lexicographer. Applicants’ arguments regarding this matter have therefore been considered but are not persuasive.

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36. Regarding Jun, the Examiner notes that June discloses an RF transponder which is used as a credit card. Applicants' arguments have been considered but are not persuasive.

37. Applicants' remaining arguments have also been considered but they too are not persuasive.

### ***Conclusion***

38. References considered pertinent to Applicants' disclosure are listed on form PTO-892. Unless expressly noted otherwise by the Examiner, all references listed on form PTO-892 are cited in their entirety.

39. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

41. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference The Bank Credit Card



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Business by the American Bankers Association (hereinafter "ABA") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that ABA is a textbook that introduces the reader to the dynamic bank credit card business. The reference is cited in its entirety. Moreover, because the reference's general description of the credit card business, because of the reference's basic content which is self evident upon review of the reference, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that ABA is primarily directed towards those of low skill in this art. Because ABA is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within ABA.

42. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (beginning on page 6) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>12</sup> the Examiner respectfully reminds

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<sup>12</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
April 7, 2005

